

The opinion in support of the decision being entered today (1) was **not** written for publication in a law journal and (2) is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER M. CLINE

Appeal No. 99-1082
Application No. 08/813,359

ON BRIEF

Before ABRAMS, McQUADE, and CRAWFORD, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, 6-15 and 17. Claim 16 has been allowed, and claims 5, 18 and 19 have been indicated as containing allowable subject matter.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a snow guard (claims 1-4 and 6-15) and to a method of preventing snow and ice from falling from roofs (claim 17). An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Zaleski	Des. 254,051	Jan. 29, 1980
McMullen	Des. 314,506	Feb. 12, 1991
Kwiatkowski et al. (Kwiatkowski)	5,570,557	Nov. 05, 1996

Claims 1, 6, 9-15 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kwiatkowski.

Claims 2-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kwiatkowski in view of McMullen.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kwiatkowski in view of Zaleski.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 10) and the Supplemental Answer (Paper No. 11) for the examiner's complete

reasoning in support of the rejections, and to the Brief (Paper No. 9) and Reply Brief (Paper No. 12) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, the applied prior art references, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

All three of the standing rejections are under 35 U.S.C. § 103. The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The question under 35 U.S.C. §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co. v. Biotech Labs., Inc. 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a

conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozak, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

This invention relates to an apparatus and method for preventing large sheets of ice or snow from sliding or falling from roofs. As manifested in independent claim 1, the snow guard comprises a base, a plate extending from the top surface of the base, support members having lower edges integrally attached to the top surface of the base and integrally attached to the plate, and multiple vents provided in the bottom surface of the base and extending inward from the side edges of the base. Independent claim 17 sets forth a method in which multiple snow guards having the structure recited in claim 1 are adhesively attached to a roof. These claims stand rejected by the examiner as being unpatentable over Kwiatkowski.

In Figure 1, Kwiatkowski discloses a snow guard that has all of the structure recited in the appellant's claim 1, except that it has a single support member rather than the plurality of members recited in the claim. However, we agree with the examiner that one of ordinary skill in the art would have found it obvious to utilize more than one support member, suggestion being found in the self-evident advantages of providing more support for the upright plate, which would have been within the skill of the artisan.¹ With regard to the requirement in the claim that there be vents in the bottom surface of the base, we point out that Kwiatkowski discloses a plurality of downwardly oriented ribs (210) defining passages that extend inwardly from the edges of the bottom surface of the base and, in view of the fact that Kwiatkowski teaches that an adhesive (60) can be placed in these grooves to facilitate attachment of the device to a roof structure, we find ourselves in agreement with the examiner that they inherently will function as "vents" for allowing gases to be evacuated during the curing of the adhesive.

It therefore is our opinion that the teachings of Kwiatkowski establish a prima facie case of obviousness with regard to the subject matter recited in claim 1.

We reach the same conclusion with regard to method claim 17. Initially, we note that Kwiatkowski teaches installing a plurality of the snow guards on a roof. In addition,

¹In an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

the reference teaches placing an adhesive in the vents on the bottom surface of the base, which would be pressed into contact with the roof when the snow guard is installed (column 4, lines 53-57). In this regard, the claim is couched in terms of a “comprising” format, which leaves it open to the inclusion of additional steps, such as the interengaging attachment feature disclosed in the reference.² Kwiatkowski therefore also establishes a prima facie case of obviousness with regard to the method of claim 17.

We thus will sustain the rejection of independent claims 1 and 17, as well as the rejection of dependent claims 6 and 9-15, the patentability of which have not been separately argued before the Board.³

While we carefully considered all of the arguments presented by the appellant in the Briefs, they did not persuade us that this rejection should not be sustained. With regard to the appellant’s argument that the Kwiatkowski snow guard is held in place by engagement with upwardly protruding elements on the surface of the roof, whereas the appellant’s is non-invasive, we observe that on page 10 of the appellant’s specification the invention is described as including countersunk holes so that the snow guard can be secured to the roof by invasive means such as fasteners. Moreover, there are no limitations in claims 1 or

²It is well settled the use of the term “comprising” in a claim opens the claim to inclusion of elements or steps other than those recited in the claim. See, for example, In re Hunter, 288 F.2d 930, 932, 129 USPQ 225, 226 (CCPA 1961

³ In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

17 that require that the snow guard be attached exclusively by non-invasive means or that preclude the use of other means in addition to the adhesive. Likewise, the arguments that Kwiatkowski does not place support members on both the front and the rear of the plate, and that the plate must be attached to the lower portion of the base rather than the upper portion, are not persuasive in that the appellant's claims are not so specific.⁴

Claims 2-4 stand rejected as being unpatentable over the combined teachings of Kwiatkowski and McMullen. Claim 2, from which claims 3 and 4 depend, adds to claim 1 the requirement that the base comprise an "elevated, longitudinal, rib-receiving channel." McMullen is a design patent directed to a snow guard in which, as shown, the upstanding plate is provided with a an elevated longitudinal channel. We do not agree with the examiner's position that it would have been obvious to one of ordinary skill in the art to add this feature to the Kwiatkowski snow guard "for additional strength," because it is "essentially a corrugation," and the use of corrugations was "well known in the construction art" to provide additional stiffness and strength to a member (Answer, page 5). First of all, the examiner has provided no evidence in support of this conclusionary statement. Second, even if the statement is accepted for the truth of the assertions made therein, McMullen teaches that the channel be placed in the upstanding plate and not in the base.

⁴See In re Self, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982).

We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to locate a longitudinal channel in the base of the Kwiatkowski device, which already is provided with a series of lateral channels that form part of the attaching means, for to do so would appear to complicate the structure of the device and compromise its attachment to the disclosed roofing system, which would have been a disincentive to the artisan. From our perspective, suggestion for this proposed modification is found only in the hindsight afforded one who first viewed the appellant's disclosure, which is improper as a basis for a rejection.⁵ The rejection of claims 2-4 is not sustained.

Claim 7 adds to claim 1 (through claim 6) the requirement that the sides of the upwardly projecting plate slope upward and inward, and claim 8 that the plate decreases in thickness as it extends upward. Zaleski discloses a snow guard in which the plate clearly has exactly that configuration (see Figures 2 and 6). In view of the fact that the appellant has attached no criticality to the claimed shapes in his disclosure, it is our position that they would have been matters of design choice well within the purview and the skill of the artisan. The rejection of claims 7 and 8 is sustained.

CONCLUSION

The rejection of claims 1, 6, 9-15 17 is sustained.

⁵In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The rejection of claims 2-4 is not sustained.

The rejection of claims 7 and 8 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

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